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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,735	05/23/2001	Naishin Seki	JA9-2000-0085 (8728-516)	9928
46069	7590	05/08/2006	EXAMINER O'CONNOR, GERALD J	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,735

Applicant(s)

Seki et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 13, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 23, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the arguments filed by applicant on April 13, 2006 in reply to the previous Office action on the merits, mailed January 19, 2006.
2. As a courtesy to applicant's client, applicant's request for withdrawal of finality is granted and, therefore, the finality of the rejection of the last Office action is hereby withdrawn.

Election/Restriction

3. Applicant's renewed traversal of the requirement for restriction, in the reply filed April 13, 2006 is hereby acknowledged. The continued traversal is on the ground(s) that:
 - (A) "the examiner should, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as a proper requirement develops";
 - (B) "fundamental fairness dictates that a new Examiner give credence to a previous Examiner's prosecution of a patent application in certain instances, such as here";
 - (C) "[the examiner's] reliance on the Applicants' amendments of 'all previous inventions' as justification for the Restriction Requirement is in stark contradiction to the Examiner's assertion (on page 10) that *all rejected claims are drawn to the same invention claimed in the application* prior to Applicants request for continued examination";

(D) the examiner stated “that all the claims have been amended and have not yet received action on the merits” and this “statement is incorrect” because “Restricted claim 12 is in its original form, has never been amended, and has been examined on several occasions”;

(E) “there must be reasonable basis for the Examiner’s classification” but here, “the Examiner’s proposed claim classifications appear to be erroneous on their face” because “claims 1-16 have been examined on several occasions and each of the claims 1-16 have been rejected as being anticipated by a single reference, Herz” and “it seems highly unlikely that a single reference Herz in class 705 can be used to support anticipation over such disparate classes and subclasses for Groups I~V as set forth in the Restriction Requirement”; and,

(F) “the claimed inventions 1-16 and even claims 17-19 have many common element and features, such that the claims may be deemed to be different definitions of the same or similar inventions, but varying in breadth or scope of definition.”

4. Applicant’s arguments have been fully considered but are not found persuasive.

5. (A) Regarding the argument that “the examiner should, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as a proper requirement develops,” the examiner in this case indeed made a proper requirement as early as possible in the prosecution--in his first action, in fact--and, in any event, prior to any action on the merits for *any* of the current claims, since *all* of the currently pending claims have been either amended or added since the last action on the merits by the prior examiner.

6. (B) Regarding the argument that “fundamental fairness dictates that a new Examiner give credence to a previous Examiner’s prosecution of a patent application in certain instances, such as here,” the examiner indeed gave credence to the previous examiner’s prosecution of the patent application. However, since all of the claims were new (i.e., never before examined), the fact that some other examiner chose not to do a restriction on some *other* set of claims has no bearing on this examiner’s decision to do a restriction on *this* set of claims, and, in fact, the other examiner would likely have done a restriction requirement at this point in prosecution of this application as well, had he remained on this case, due to applicant’s extensive amendment of all existing claims and further addition of new claims, and since 37 CFR § 1.142 explicitly provides that a requirement for restriction, “may be made *at any time* before final action” (emphasis added).

7. (C) Regarding the argument that “[the examiner’s] reliance on the Applicants’ amendments of ‘all previous inventions’ as justification for the Restriction Requirement is in stark contradiction to the Examiner’s assertion (on page 10) that *all rejected claims are drawn to the same invention claimed in the application* prior to Applicants request for continued examination,” there is no contradiction at all, much less any stark one. Applicant apparently does not understand the simple distinction between “all claims” and “all rejected claims.” Note that, in view of the requirement for restriction, *not all* of the new/never-before-examined claims were examined on the merits and rejected. *Only one* of the several claimed inventions was examined and rejected. That particular one, the one applicant chose to have examined, just so

happened to be drawn to the same invention as had been rejected before. Obviously, that *does not necessarily mean* that the claims of *that* group had *not* been amended (i.e., changed from what had been presented before), *nor does it necessarily mean* that any of the several other inventions were necessarily also drawn to that same particular invention.

8. (D) Regarding the argument that the examiner stated “that all the claims have been amended and have not yet received action on the merits” and this “statement is incorrect” because “Restricted claim 12 is in its original form, has never been amended, and has been examined on several occasions,” note that claim 12, as presented, was being presented for the first time and had *never* been previously examined. Applicant is presumably referring to the status of claim 12 being styled as “original” (i.e., never amended), and it is true that the text of claim 12 *per se* has not changed. However, applicant apparently does not understand that claim 12 is a *dependent claim*, as opposed to an *independent claim*, which are two entirely different things. A dependent claim always refers to another claim and *includes all of the limitations of that other claim*, in this case claim 11, *in addition to* the limitations explicitly recited in the dependent claim itself, in this case claim 12. Therefore, since independent claim 11 had been amended, not only was the current claim 11 being presented for the first time, but any and all dependent claims depending from claim 11 also included all of those same changes, thus were also being presented for the first time.

9. (E) Regarding the argument that “there must be reasonable basis for the Examiner’s classification” but here, “the Examiner’s proposed claim classifications appear to be erroneous on their face” because “claims 1-16 have been examined on several occasions and each of the claims 1-16 have been rejected as being anticipated by a single reference, Herz” and “it seems highly unlikely that a single reference Herz in class 705 can be used to support anticipation over such disparate classes and subclasses for Groups I~V as set forth in the Restriction Requirement,” the argument has been deemed specious, since *none* of the claims subjected to the requirement for restriction had been rejected over Herz or any other reference, since all of the pending claims at that time were being presented for the first time. In addition, the fact that a single reference could be used to reject all of *previous* claims 1-16 is merely evidence of the inordinate breadth of applicant’s *prior* claims, not any impropriety of any requirement for restriction, particularly of applicant’s *current* claims.

10. (F) Regarding the argument that “the claimed inventions 1-16 and even claims 17-19 have many common element and features, such that the claims may be deemed to be different definitions of the same or similar inventions, but varying in breadth or scope of definition,” no requirement for restriction is precluded by virtue of the claims having many common elements and features, such that the claims may be deemed to be different definitions of the same or similar inventions, but varying in breadth or scope of definition.

11. The restriction requirement is still deemed proper and therefore remains FINAL.

12. Claims 10-19 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed November 14, 2005.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al. (US 2001/0014868).

Herz et al. shows, in Figure 1, a system for the automatic determination of customized prices and promotions. The primary functions of the system for the automatic determination of customized prices and promotions (price setting means) 100 are (1) to identify offers that are

appropriate for each shopper, (2) to help the shopper become informed about these available offers (product information provision means), and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment (retail means), if the shopper decides to accept an offer. Demographic and/or consumer information about the shopper or similar shoppers is obtained from other databases, e.g., from a consumer database purchased from a credit-card company, or a database that correlates the response to telemarketing campaigns with demographic variables. The main computer selects offers from the offer database that are likely to result in profitable sales (price trend means, basic rule of supply and demand). “Retail sales state” and means for managing it, as vaguely defined in applicant’s specification, is shown throughout the reference in demand curves and more specifically on page 32, paragraph 301, which states, “Time series methods are also useful for detecting trends; one could do a linear regression on sales for a certain product over time, determining the overall direction of a product’s sales. This information could be used to adjust offer-generating strategies, as it would indicate a waxing or waning of a customer’s overall interest in a given product.”

Response to Arguments

15. Applicant’s arguments filed April 13, 2006 have been fully considered but are not persuasive.
16. Regarding the argument that the Office action fails to make “specific reference to sections of Herz showing how the claimed features are disclosed,” the Office action indeed makes specific reference to sections of Herz showing how the claimed features are disclosed.

17. Regarding the argument that “it is [the examiner’s] burden to formulate a reasonable basis for the rejection, applicant is actually correct, but, in this case, the examiner has indeed formulated a reasonable basis for the rejection. See § 14, hereinabove.

18. Regarding the argument that “it is not the Applicant’s burden to explain how Herz differs from the claimed invention,” actually, it is.

See, for example, 37 CFR § 1.111(b), which requires that, “The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

See also, for example, 37 CFR § 1.111(c), which requires that, “In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.”

19. Regarding the argument that Herz et al. do not disclose “product information provision means,” Herz et al. indeed disclose product information provision means. Otherwise, the offers could not be made to the shoppers. Note that the arrangement of Herz et al. comprises each shopper interacting with the automatic determination of customized prices system, which interaction necessarily includes requesting and receiving of information. The additional claim

recitations, drawn to extensively recited functional language which the claimed apparatus is envisaged to perform, have been deemed merely intended usage of the invention, hence, afforded little patentable weight. The actual claimed structural elements recited by the arguments include merely “product information provision means,” followed by an extensive description of intended usage that the recited element of “product information provision means” is envisaged to perform, for example, “for, upon the receipt of an information request regarding said product from a user via said communication network, furnishing the user with the information concerning said product and said price of said product.”

Note that recited functional language is ordinarily deemed merely intended usage of an invention, hence, afforded little patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A recitation of an intended use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See MPEP §2114.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to the disclosure.

21. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

May 2, 2006

 5/2/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627